

DN GSIE 8803US

RCE and Amendment Dated June 24, 2005

Reply to Office Action of March 28, 2005

REMARKS

Claims 1-35 are pending. Claims 1-35 are rejected. Claims 1, 11, 21, 23, and 34 are amended herein. Claims 36 and 37 have been added.

Summary of Interview

Applicant and his attorney thanks the Examiner for the personal interview on June 16, 2005. During the interview, applicant exhibited models of the prior art and the invention of the pending application. The prior art was discussed, specifically, U.S. Pat. 6,138,649 issued to *Khair* and U.S. Pat. 5,027,781 issued to *Lewis*. It was agreed that claims 1, 11, 21, 23, and 34 would be allowable over the prior art of record with the proposed amendment specifying a screen without a catalyst or an intake pipe located at an exhaust manifold, pending further search and consideration. It was also agreed that claim 32 is allowable over *Lewis*, pending further search and consideration, because the prior art does not disclose the screen affixed with an interference fit.

Rejection of Claims 1, 6, 8-11, and 17-20 Under 35 U.S.C. §102.

Claims 1, 6, 8-11, and 17-20 are rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Pat. No. 6,138,649 to *Khair*.

Claim 1 has been amended to include a screen "without a catalyst." Claim 11 has been amended to include a screen "positioned adjacent to an exhaust manifold".

DN GSIE 8803US

RCE and Amendment Dated June 24, 2005

Reply to Office Action of March 28, 2005

As agreed during a personal interview with examiner on June 16, 2005, none of the prior art cited by examiner discloses either of these elements.

The MPEP states,

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference."
Verdegaal Bros. V. Union Oil Co. of California, 814 F.2d 628, 631 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987).

MPEP § 2131.

Since *Khair* fails to describe a screen "without a catalyst" or a screen "positioned adjacent to an exhaust manifold", applicant submits that *Khair* does not suggest or disclose at least one element specifically required by independent claims 1 and 11 and, thus, the claims are not anticipated by *Khair*. Therefore, Applicant respectfully requests that the rejection of claims 1 and 11 be withdrawn.

Claims 2-10 depend from base claim 1, and therefore, incorporate all of the subject matter of claim 1. Claims 12-20 depend from base claim 11, and therefore, incorporate all of the subject matter of claim 11. Because a dependent claim cannot be anticipated if the independent claim from which it depends is not anticipated, all other dependent claims of the present application must also be found unanticipated. Since claim 1 is patentable over *Khair*, applicant also submits that claims 2-10 are patentable over *Khair* for the same reasons. Likewise, since claim 11 is patentable over *Khair*, applicant also submits that claims 12-20 are patentable over *Khair*. Therefore, applicant requests that the rejection of claims 1-10 and 11-20 be withdrawn.

DN GSIE 8803US

RCE and Amendment Dated June 24, 2005

Reply to Office Action of March 28, 2005

Rejection of Claims 32 and 33 Under 35 U.S.C. §102.

Claims 32 and 33 are rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Pat. No. 5,027,781 to *Lewis*.

As agreed during the personal interview with examiner on June 16, 2005, none of the prior art cited by the Examiner discloses a screen "affixed to the intake pipe solely with an interference fit." Therefore, applicant submits that *Lewis* does not suggest or disclose at least one element specifically required by claims 32 and 33 and; thus, are not anticipated by *Lewis*. Therefore, Applicant requests that the rejection of claims 32 and 33 under U.S.C. §102 (b) be withdrawn.

Rejection of Claims 2-5, 12-16, 21-31, 34, and 35 Under 35 U.S.C. §103.

Claims 2-5, 12-16, and 21-31 are rejected under 35 U.S.C. §103(a) as being unpatentable over *Khair* in view of legal precedent and/or official notice.

As discussed above, independent claims 1 and 11 contain at least one element specified in independent claims 1 and 11 that is not suggested, disclosed, or claimed at all in *Khair*. As a result, there is no *prima facie* case of obviousness as required under patent law and in accordance with the Manual of Patent Examining Procedure ("MPEP"). The MPEP states,

"To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references

Page 10 of 13

DN GSIE 8803US

RCE and Amendment Dated June 24, 2005

Reply to Office Action of March 28, 2005

themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all of the claim limitations. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed., Cir 1991) See MPEP § 2143 - § 2143.03 for decisions pertinent to each of these criteria."

MPEP § 706.02(j) (emphasis added). The MPEP also states,

"To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q.2d 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 U.S.P.Q. 494, 496 (CCPA 1970). If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988)."

MPEP § 2143.03 (emphasis added).

Because *Khair* does not disclose a screen "without a catalyst" or "positioned adjacent to an exhaust manifold", there is no *prima facie* case of obviousness against independent claims 1 or 11.

It is noted that independent claim 1 forms the basis for all dependent claims 2-10, and independent claim 11 forms the basis for dependent claims 12-20. Because a dependent claim cannot be obvious if the independent claim from which it depends is not obvious, all claims depending from claims 1 and 11 must also be found nonobvious.

Claims 21 and 23 have been amended to a screen "without a catalyst". As discussed above, *Khair* does not disclose a screen "without a catalyst". Therefore, there is no *prima facie* case of obviousness against independent claims 21 and 23.

Page 11 of 13

DN GSIE 8803US

RCE and Amendment Dated June 24, 2005

Reply to Office Action of March 28, 2005

Therefore, Applicant respectfully requests that the rejection of claims 21 and 23 U.S.C. §103 (a) be withdrawn.

It is noted that independent claim 21 forms the basis for dependent claim 22, and independent claim 23 forms the basis for dependent claims 24-31. Because a dependent claim cannot be obvious if the independent claim from which it depends is not obvious, all claims depending from Claims 1 and 11 must also be found nonobvious.

Claims 34 and 35 are rejected under 35 U.S.C. §103(a) as being unpatentable over *Khair* in view of *Lewis*. Claim 34 has been amended to include a screen "positioned adjacent to an exhaust manifold". As agreed during a personal interview with examiner on June 16, 2005, none of the prior art cited by examiner discloses a screen "positioned adjacent to an exhaust manifold." Therefore, applicant submits that *Khair* and *Lewis* does not suggest or disclose at least one element specifically required by claims 34 and 35 and, thus, the claims are not obvious in view of *Khair* and *Lewis*.

In light of the above, Applicant therefore respectfully requests that the Examiner withdraw the rejection of Claims 2-5, 12-16, 21-31, 34, and 35 as being obvious under 35 U.S.C. § 103.

New Claims 36 and 37.

Claims 36 and 37 have been added. They are dependent on Independent claims 1 and 23 respectively. None of the references of record, either independently or in combination, teach or suggest the claimed subject matter of Claims 36 and 37.

DN GSIE 8803US

RCE and Amendment Dated June 24, 2005

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Therefore, applicant submits that Claims 36 and 37 constitute allowable subject matter and should be favorably considered by the Examiner, and applicant respectfully requests that a timely Notice of Allowance be issued for those Claims.

Conclusion.

Applicant believes the above analysis and the amendments made herein overcome all of the Examiner's rejections and that Claims 1-37 are in condition for allowance. Applicant respectfully requests that a timely Notice of Allowance be issued for those Claims.

The Commissioner is hereby authorized to charge any additional fees or credit overpayment under 37 CFR 1.16 and 1.17 which may be required by this paper to Deposit Account 162201.

Respectfully submitted,

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Scott Anthony Smith,
Registration No. 46,067
POLSTER, LIEDER, WOODRUFF & LUCCHESI, L.C.
12412 Powerscourt Drive, Suite 200
St. Louis, MO 63131-3615
Telephone: (314) 238-2400
Facsimile: (314) 238-2401